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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YONG-SEOK SONG *et al.*

Serial No.: 10/032,481

Examiner: VO, TUYET THI

Filed: 2 January 2002

Art Unit: 2821

For: ELECTRON GUN FOR COLOR CATHODE RAY TUBE

PETITION UNDER 37 C.F.R. §1.181

Mail Stop

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully request reconsideration and withdrawal of the finality of the rejection of the last Office action, and as reasons therefore states that:

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STATEMENT OF FACTS

1. Applicants filed a patent application on 2 January 2002 setting forth claims 1-17.
2. The U.S. Patent and Trademark Office mailed a non-final Office action on 4 December 2002 (Paper No. 4). The Examiner rejects claims 1-4, 8-10, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,350,967 issued to Chen (Chen '967) (Paper No. 4, p. 2). The Examiner indicates that the dependent claims 5-7, 11, 12, and 14-17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Paper No. 4, p. 3).
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3. Applicants filed a response on 24 February 2003. The response filed on 24 February 2003 does not amend any of the claims 1-17. The response filed on 24 February 2003 does include remarks explaining why the Applicants respectfully believe that the rejection of claims 1-4, 8-10, and 13 is improper. Also, because the Examiner indicated that the dependent claims 5-7, 11, 12, and 14-17 included patentable subject matter, the response filed on 24 February 2003 includes remarks asking that the Examiner hold the status of the dependent claims 5-7, 11, 12, and 14-17 in abeyance while the Examiner considers the remarks of the Applicants. The response filed on 24 February 2003 does add new claims 18-22, and does explain why those newly added claims are respectfully believed to be allowable.
4. The U.S. Patent and Trademark Office mailed a final Office action on 21 April 2003 (Paper No. 6). The Examiner relies upon a combination of Chen '967 and a newly cited second reference, U.S. Patent No. 4,374,341 issued to Say (Say '341),

to reject claims 1-4, 8-10, 13, and 18-21 (Paper No. 6, p. 2). The Examiner indicates that the dependent claims 5-7, 11, 12, 14-17, and 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Paper No. 6, p. 3).

REMARKS

The Applicants respectfully believe that the final Office action mailed on 21 April 2003 (Paper No. 6) is a premature final Office action for the following reasons.

The Applicants respectfully believe that the final Office action mailed on 21 April 2003 (Paper No. 6) is a premature final Office action because Paper No. 6 includes a rejection, on newly cited art, of claims 1-4, 8-10, 13, when the claims 1-4, 8-10, and 13 were not amended by the Applicants.

The *Manual of Patent Examining Procedure* (MPEP) states “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art” (MPEP § 706.07(a)).

Therefore, the MPEP § 706.07(a) indicates that a second action on the merits ***will not be***

made final if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art.

The Applicants filed a patent application on 2 January 2002 setting forth claims 1-17. The U.S. Patent and Trademark Office mailed a non-final Office action on 4 December 2002 (Paper No. 4), in which the Examiner rejects claims 1-4, 8-10, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,350,967 issued to Chen (Chen '967). The Applicants filed a response on 24 February 2003 and did not amend claims 1-17. Subsequently, the U.S. Patent and Trademark Office mailed a final Office action on 21 April 2003 (Paper No. 6), wherein the Examiner relies upon a combination of Chen '967 and a second reference, Sah '341, to reject the claims 1-4, 8-10, and 13. The second reference, Sah '341, is a newly cited reference.

The Applicants respectfully believe that the remarks included in the Applicants' response filed on 24 February 2003 were fully responsive to all of the issues discussed in Paper No. 4. For example, in the Applicants' response, the Applicants respectfully traverse the rejection of claims 1-4, 8-10, and 13, and the Applicants respectfully explain why the § 102 rejection of claims 1-4, 8-10, and 13 is believed to be improper, in detail, on pages 5-9 of the response filed on 24 February 2003.

The rejection of claims 1-4, 8-10, and 13 in Paper No. 6 includes a new ground of rejection because a newly cited reference is relied upon in a § 103 rejection, while the rejection in Paper No. 4 was a § 102 rejection. The Examiner acknowledges that there are new ground(s) of rejection in

Paper No. 6, because the Examiner states “Applicant's amendment ... have been considered but are moot in view of the new ground(s) of rejection” (Paper No. 6, p. 2).

The Paper No. 6 is not clear because at least one of the dates shown therein is ambiguous or incorrect. The Examiner states that “Applicant's amendment filed February 13, 2003 have been considered but are moot in view of the new ground(s) of rejection” (Paper No. 6, p. 2). The Applicants respectfully note that an amendment was filed on 24 February 2003.

The rejection in the final Office action is not clear because it cites 35 U.S.C. § 103 but utilizes the language of a § 102 rejection. The Examiner states that “Claims 1-4, 8-10, 13 and 18-21 are rejected under 35 U.S.C. 103(a) as being anticipated by Chen (US Pat. 5,350,967) in view of Say (US Pat. 4,374,341)” (Paper No. 6, p. 2).

After the Examiner received the Applicants' response filed on 24 February 2003, the Examiner relied upon the newly cited reference Sah '341 to reject the claims 1-4, 8-10, and 13, and the Examiner relied upon new grounds of rejection to reject the claims 1-4, 8-10, and 13, even though the claims 1-4, 8-10, and 13 were not amended.

For all of the foregoing reasons, the Applicants respectfully believe that the Paper No. 6 is a premature final Office action.



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RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

- A. Reconsider the finality of the rejection of the last Office action (Paper No. 6);
- B. Withdraw the finality of the last Office action (Paper No. 6); and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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